

SENSING THE CONSTITUTION IN *FEIST*

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The United States Supreme Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹ has invited analysis along many lines of inquiry. In most instances, the practitioners and scholars who have considered the case have brought to their work an admirable pragmatism and focus for which one can be grateful.²

Meanwhile, I intend to pursue a line of inquiry of my own - an inquiry which is neither focused nor practical, at least not in any immediate sense, but which has been much on my mind since I first read *Feist* last spring.

What I want to know is this: Is *Feist* just another in a long series of false starts, missed opportunities, and wrong turns on the road to constitutional harmonization in the field of intellectual property in America? Or is it possible, as I think it may be, that what makes *Feist* worthy of the close attention it is getting is that in this case, at last, the Court has signalled its intention to begin the serious business of bringing to intellectual property the constitutional coherence it deserves? In these remarks I will consider each of these alternatives briefly.

I.

Surely I need not dwell at length on false starts, missed opportunities or wrong turns. There can be few more remarkable chapters in the saga of American constitutional law than the story of how we have nurtured freedom of expression under the first amendment on the one hand, even as we have tolerated the systematic suppression of expression under conventional intellectual property doctrines on the other. I understand, of course, that the first amendment and intellectual property are to be taken as "reconciled;" for that matter, I have no difficulty reconciling them myself when I am obliged to do so. But then, I have no difficulty believing six impossible things before breakfast ei-

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1. 111 S. Ct. 1282 (interim ed. 1991).

2. Consider, for example, the "highly focused and practical analysis" by "leading private practitioners, noted academics and affected industry leaders" assembled for a course on *Feist* offered last December in Washington. The sponsor, Prentice Hall, promised to "cover all the bases" in a "timely seminar" on the "New Era of 'Fact' and Data Protection . . . [under] *Feist* and its Progeny" *New Era of "Fact" and Data Protection . . . [under] Feist and its Progeny*, PRENTICE HALL LAW & BUSINESS BROCHURE (Washington, D.C. Dec. 9, 1991).

ther, when I must. And yet privately, like Alice, I know that what is is: nonsense is nonsense; and it is nonsense to think that we can reconcile the first amendment with intellectual property under existing doctrines. We might as well try knitting vests with sleeves.³

Some day, we are going to have to take this conflict seriously. Some day we will have to decide which we value more: our right to express ourselves at will; or our right to possess, exclusively, those elements in our culture that once we shared with others, *res communes*.⁴ The one is consistent with our general right to think as we please and speak as we think, a right which for centuries has served as the very definition of public happiness. The other, I fear, is consistent with what the sardonic Luis Bunuel once called "the discreet charm of the bourgeoisie."

How could we have arrived at the new millennium without knowing what we think about these matters? I believe, at least partly, that we have lived so spaciouly until now that we have simply not confronted our neighbors: the fields within which authorship and self-expression lie are vast, and our reach has been less than our grasp. But new technologies, newly intimate in our lives, have changed that. Now we range where we please, seizing what comes to hand as we pass by.

3. The literature on the First Amendment/intellectual property conflict is extensive. A representative, and particularly good, recent piece (which collects much of the previous work on the subject) is Fred Yen's reflection on the problems posed by the "total concept and feel" standard in copyright. See Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 EMORY L.J. 393 (1989). For a still more recent, equally excellent treatment, see also *Copyright and Free Speech Rights*, in L. RAY PATTERSON & STANLEY W. LINDBERG, *THE NATURE OF COPYRIGHT* 122-33 (1991).

4. *Res communes*, originally a concept in Roman law, seems an apt way to sum up the essential nature of the public domain, which is what is at stake in this conflict. I owe my introduction to the phrase to two former students at the Duke Law School, Sanna Franklin and Judith Sapp, who suggested it in the course of tutorial research some years ago.

The conflict between First Amendment values and cultural appropriation is especially problematic given the fact that most judges and intellectual property lawyers simply do not recognize its existence in everyday settings. See generally Alfred C. Yen, *supra* note 3. In the course of an especially powerful and sophisticated exploration of the issue of cultural appropriation via intellectual property doctrines, Rosemary Coombe observes: "Arguably, fewer and fewer defenses are available in intellectual property infringement actions; free speech defenses are inconsistently interpreted and often dismissed without due consideration. More troubling, however, is the likelihood that freedom of expression arguments will not even be asserted." Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1866-67 (1991). Coombe may think, as I do, that the First Amendment alone cannot be counted on as the instrument for constraining the development of intellectual property doctrines. See *id.* at 1876 n.133. For me it follows that we should pay more attention to the development of the so-called "intellectual property clause" in the U.S. Constitution, and especially to the constraints that clause implies-essentially as I believe *Feist* does. But Coombe, meanwhile, writing as a Canadian scholar whose perspectives are both transnational and postmodern, develops an intriguing Bakhtinian argument for constraint from within the intellectual property dialogue itself. See *id.*

Consider our physical relationship with the text—any text. When I entered the practice of law not quite thirty years ago, the firm I joined (then the oldest in the city) still possessed a letter press; there was no Xerox machine; the IBM Correcting Selectric lay a few years ahead. Today I interface and download what I want; I fax, scan, convert the font, edit at will; I copy, add sound when I need to, delete frames, alter scenes, format, aspect ratio. I am, in short, omnipresent in the text, and I am accordingly an author of all I survey. No less so are we all.⁵

Could we have anticipated our time in cases a century, or even a generation, ago? I think we might have, in a case like *Burrow-Giles*

5. Or so I think, at any rate. Others disagree. Jessica Litman collects the literature and sums up the controversy usefully in a recent article on the impact technology has had on copyright legislation in the past decade or so. She writes:

Recent commentary reflects a dispute over whether the copyright statute can adjust to the current climate of rapid technological change. One camp argues that current technology differs profoundly from prior development and calls into question the assumptions on which our copyright laws are based. Another camp insists that copyright law has always faced the problem of technological change and accommodated it with remarkable success. The current challenge, the argument continues, is not qualitatively different from previous challenges, and the copyright statute is equal to the task.

Jessica Litman, *Copyright Legislation and Technological Change*, 68 OR. L. REV. 275, 276 (1989) (citations omitted). Litman herself observes that "both camps rely heavily on received wisdom about the history of the interaction between copyright and technology. Both, therefore, proceed on the assumption that copyright law has been effective, until now, in assimilating technological development; in fact, it has not." *Id.* at 276-77 (citations omitted).

I am not a futurist, and I claim no special expertise in the subject of technology. Most of what I think in this context is intuitive, rather than tutored. But I am firmly in the fin-de-siecle "camp" for two reasons. First, because I sense in today's technology an intimacy which earlier technologies simply do not seem to have achieved, as a matter of historical record. Second, because this intimacy is simply inconsistent, I think—inconsistent, that is to say, in terms I believe to be deeply essential in human kind—with the capacity for forbearance from self-expression that the continued existence of intellectual property as we have known it presupposes. Surely neither of these insights is original with me, or at least I cannot imagine so; and I would welcome readers' references to the work of others in which the points are better or more fully made.

Meanwhile, I have already speculated about the implications these insights hold for intellectual property in the postmodern millennium in an article soon to be published in another journal. See David Lange, *At Play in the Fields of the Word*, — LAW & CONTEMP. PROBS. (forthcoming Spring 1992).

Tom Palmer argues persuasively that intellectual property doctrines are themselves the consequence of specific technology, notably the press. He suggests in turn:

The relationship between intellectual property rights and technology poses a very important question: If laws are dependent for their emergence and validation upon technological innovations, might not succeeding innovations require that those very laws pass back out of existence? Today this question should be considered in the context of drastically lowered costs of reproduction and transmission, increased costs of enforcement, problems arising from indeterminate or collective authorship due to new applications of computer technology, and similar issues. One need not conclude from such considerations that copyright did not emerge legitimately in a world of typography, but one should at least be led to question whether it fulfills a legitimate role in a world of electronics.

Tom G. Palmer, *Intellectual Property: A Non-Posnerian Law and Economics Approach*, 12 HAMLINE L. REV. 261, 273 (1989).

Lithographic Co. v. Sarony,⁶ in which the Court could have said something about the impact a new, visual technology surely would have on a print-bound doctrine, but simply failed to grasp the implications in the case—or perhaps, rather, failed merely to act on the insight it may actually have had.⁷ I think we might have in *Bleistein v. Donaldson Lithographing Co.*,⁸ in which Holmes, delphic as always, asked us to imagine copying the original but not the copy, but failed himself to imagine what that would mean in the landscape photography of Ansel Adams.⁹ I think we might have in *Time, Inc., v. Bernard Geis Associates*,¹⁰ in which the district court saw the case clearly enough in terms of justification, but failed altogether to understand it in terms of simple entitlement.¹¹

I think we might have anticipated our time in *The Trade-Mark Cases*,¹² which distinguished trademarks from copyright in constitutional terms that justify us even now in having a second look at that decision. Indeed, Justice O'Connor herself relies on *The Trade-Mark Cases* in her opinion in *Feist*. And it is just here that we may begin to sense possibilities in *Feist* more sweeping than we have encountered in any other case before.

6. 111 U.S. 53 (1884).

7. It may be revealing of what Harry Kalven called "the insight more important than we can use" that the best discussion of *Burrow-Giles* ever published actually appears in a new book of critical cultural studies written by an English professor at Duke. See *Photography Surprises the Law: The Portrait of Oscar Wilde*, in JANE GAINES, *CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW* 42-83 (1991).

8. 188 U.S. 239 (1903).

9. Who but Adams, for example, can safely claim ownership in the moonrise above Hernandez, New Mexico, whether original or copy? Given the replicative capacity in photographic technology, as well as the presumptions that arise in copyright from striking similarity, not to mention the implications in derivative works theory, the answer is, no one can. In a very real sense, at least since 4:05 p.m., Friday, October 31, 1941, the original has been imprisoned in the copy. See ANSEL ADAMS, *Moonrise*, in *EXAMPLES: THE MAKING OF 40 PHOTOGRAPHS* 40-43 (1983).

10. 293 F. Supp. 130 (S.D.N.Y. 1968).

11. Judge Thompson, the author in *Geis*, wasn't trying to copy protected expression. He didn't want protected expression. In fact there was nothing he wanted less than the protected expression, which was at best a distraction, and at worst a potential challenge to his theory. What he wanted was the event, pure and simple. But, like the moonrise in *Moonrise*, the event was imprisoned in the copy. Under *Geis*, he could hope for no better than the justification for a "taking" that fair use sometimes recognizes. Under *Feist*, extended, he might one day hope for the facts themselves as a matter of right, freed from the otherwise inextricable encumbrance of copyright by the very "thinness" of its embrace. Cf. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1289 (interim ed. 1991).

12. 100 U.S. 82 (1879).

II.

When Justice O'Connor cites *The Trade-Mark Cases*, as she does, *passim*, for the proposition that the "sweat of the brow" doctrine has no constitutional place in the law of copyright, what exactly are we to make of the point? In 1879, when *The Trade-Mark Cases* were decided, the distinction must have seemed clear: copyright was copyright, and Congress was empowered to enact copyright legislation only when the legislation comported with the standards contained within the Copyright Clause; trademarks, meanwhile, were separate rights, and whatever power Congress might draw upon to justify protecting trademarks, that power would have to be found somewhere other than within the Copyright Clause. You may well remember the relevant language in *The Trade-Mark Cases*, but in any event here it is again from the opinion by Mr. Justice Samuel Miller:

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition. If the symbol, however plain, simple, old, or well-known, has been first appropriated by the claimant as his distinctive trade-mark, he may by registration secure the right to its exclusive use. While such legislation may be a judicious aid to the common law on the subjects of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitu-

tional provision concerning authors and inventors, and their writings and discoveries.¹³

Had I lived as a lawyer in 1879, I suppose I would have understood the distinctions entertained by Mr. Justice Miller in *The Trade-Mark Cases*, and I would have embraced them, I imagine, unhesitatingly. Even today, where copyright is concerned, the passage from the opinion cited here is still strong—and not just strong, but profoundly right as well. Indeed the opinion says very nearly all one would want to hear said about copyright and the requirements of Article I, Section 8, Clause 8 of the Constitution at the level of constitutional constraint. Were we to add to this passage a few complementary, and equally compelling, passages from *Graham v. John Deere Co.*,¹⁴ then we might be tempted to imagine that we had all the jurisprudence we need for our time—all the jurisprudence necessary, that is to say, for intellectual property in the post-modern, post-literate millennium.

But *The Trade-Mark Cases* are not about intellectual property; they are merely about copyright and trademarks. And the distinctions between these two doctrinal fields—so eminently sensible in 1879, and so admirably delineated in that case—are now quite illusory in 1991. Indeed, one actually has the sense, recalling these distinctions in *Feist*, of somehow living before one's own time, more or less as though the day's post had brought a long-delayed invitation to take the waters at Marienbad. The problem with *The Trade-Mark Cases* today is simply the problem Gertrude Stein encountered when she finally arrived in

13. *Id.* at 94.

14. 388 U.S. 1 (1966).

At the outset it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress "To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." The clause is both a grant of power and a limitation. This qualified authority, unlike the power often exercised in the sixteenth and seventeenth centuries by the English Crown, is limited to the promotion of advances in the "useful arts." It was written against the backdrop of the practices—eventually curtailed by the Statute of Monopolies—of the Crown in granting monopolies to court favorites in goods or businesses which had long before been enjoyed by the public The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must "promote the Progress of . . . useful Arts." This is the *standard* expressed in the Constitution and it may not be ignored. And it is in this light that patent validity "requires reference to a standard written into the Constitution."

Id. at 5-6 (citations omitted).

Oakland: there is no there there. I wonder whether that may yet prove to be the problem with *Feist* as well.

Of course it is too soon to know the answer to a question of that character. It is not too soon, however, to sense what manner of influences will have shaped the answer when it finally becomes clear. *Feist* will prove to be an empty precedent if it serves merely to reinforce distinctions that seemed natural in *The Trade-Mark Cases*. The day is past when distinctions like these can suffice. Formalist in nature and therefore essentially bereft of meaning today, constitutional distinctions between trademarks and copyright, for example, now serve mainly to obscure the appropriative nature of both doctrinal fields. We have merely to observe how proponents of moral rights today seek sanctuary in amendments to section 43(a) of the Lanham Act to see in turn that 1879 distinctions have become the refuge of the cynical realists among us. But the Constitution in our time should leave no room for such cynicism. Congress is empowered to grant exclusive rights to authors and inventors for limited times solely in order to promote the progress of science and the useful arts. This is the constitutional standard, the Court has said, and the standard constrains; its limits cannot properly be avoided through the simple device of calling authorship (read: appropriation) by another name.

Feist will prove not to be an empty precedent only if the decision in that case prompts us to reinscribe the outcome there in other settings as well: to insist, in other words, that no interest, property-like in character, can ever be recognized under the constitution in any expression that does not in fact meet the constitutional tests of originality and creativity. To achieve that end we must also be willing to re-imagine *The Trade-Mark Cases* themselves, as though they were to be transposed to our time. *Feist* prompts us to do exactly that. And if, in prompting us to reconsider these matters, *Feist* should lead us finally to realize that in an age of intellectual property we must be governed under the Constitution—not by a copyright or patent clause but rather by an intellectual property clause—then, most assuredly, *Feist* will not be an empty precedent at all.

Is it realistic to suppose that *Feist* can take us in this direction? Certainly not in terms of the immediate decision, nor much in terms of the language immediate in the opinion. And yet I would insist that there is reason to anticipate more from the case than meets the eye.

The key to understanding both the limits and the possibilities in any precedent is, indeed, to see it in relation to its own time. *The Trade-Mark Cases* exactly mirrored the times: there was, literally, no occasion to go beyond the reach of the opinion there. *Feist*, too, can be said to perfectly reflect its time. What the opinion in *Feist* recognizes is

that we cannot go on tolerating the appropriation of our culture that aging precedents in the intellectual property field allow.¹⁵ *Feist* was decided, I would say, precisely because the Court recognized an intolerable situation in the telephone directory cases, and a situation all the more intolerable for the fact that it derived from doctrinal positions nearly a century old.

The origins of whatever jurisprudence there may be in *Feist*, then, do not lie finally in the Nineteenth century. They lie in such late Twentieth Century achievements as fiber optics and the microchip. So long as these and scores of related technologies hold sway in our time, we can expect the Court to respond with constitutional doctrines suited to the need. And in this sense, then, *Feist* may well signal the beginning of a new era of coherence in the constitutional law constraining intellectual property.¹⁶

15. See generally GAINES, *supra* note 7; see also Coombe, *supra* note 4.

16. Compare the similar suggestion in a recent work by Howard Abrams. Howard Abrams, *Originality and Creativity in Copyright [After Feist]*, — LAW & CONTEMP. PROBS. (forthcoming 1992).